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LARSON NEWMAN & ABEL, LLP 5914 WEST COURTYARD DRIVE SUITE 200 AUSTIN, TX 78730			AUSTIN, AARON	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VENKAT SELVAMANICKAM
and HEE-GYOUN LEE

Appeal 2009-006286
Application 10/602,468
Technology Center 1700

Before BRADLEY R. GARRIS, CHUNG K. PAK, and
CHARLES F. WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 23-34 and 36-43 in the Office Action mailed April 13, 2008. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

§ 41.31(a) (2008).

We reverse the decision of the Primary Examiner.

Claim 23 illustrates Appellants' invention of a superconductive article, and is representative of the claims on appeal:

23. A superconductive article comprising:

a substrate tape; and

a superconductive layer, wherein the superconductive layer comprises a plurality of individually identifiable superconductive films of the same material, the plurality of individually identifiable superconductive films (i) comprising at least 3 superconductive films, and (ii) being disposed one atop another, atomically bonded to each other, and free of intervening bonding layers between superconductive films.

Appellants request review of the ground of rejection under 35 U.S.C. § 103(a) advanced on appeal by the Examiner: claims 23-34 and 36-43 over Mannhart (US 2005/0173679 A1). App. Br. 4; Ans. 3.

Opinion

We agree with Appellants that the Examiner erred in determining that the disclosure in Mannhart Example 1 would have led one of ordinary skill in the art to use, among other film growth processes, the metal organic chemical vapor deposition (MOCVD)² film growth process to apply three superconductive layers on a tape to form a superconductive article having a superconductive layer comprising at least three superconductive films of the same material that are disposed one atop another, atomically bonded to each other, and free of intervening bonding layers disposed one atop the other without intervening bond layers, as claimed in representative claim 23.

Ans. 4-10, citing Mannhart ¶¶ 0039, 0041, and 0042, and Fig. 5; App. Br.

5-7, citing Mannhart ¶¶ 0035, 009, 0041, and 0042, and Fig. 5, and the Selvamanjckam Declarations (Declarations);³ Reply Br. 4-5.

Appellants submit that individually identifiable and atomically bonded films inherently result from the particular MOCVD process disclosed in the Specification as Dr. Selvamanjckam attests in the Declarations. App. Br. 5; Reply Br. 4. Appellants contend that there is no evidence in Mannhart that any MOCVD process achieves the same result. App. Br. 5-7; reply Br. 4-5.

We find that in the Declaration filed August 7, 2007, Dr. Selvamanjckam attests that the multi-zone MOCVD process described at “pages 23+ in connection with FIGs. 1-4b” of the Specification results in the claimed characteristics of the superconductive layer.⁴ 2007 Decl. ¶¶ 5 and 6. Indeed, we make the same findings. Spec., e.g., 23-36, Specification Tables 1 through 5, and Figs. 1-4b.

With respect to the “MOCVD” process disclosed in Mannhart, the Examiner contends that, in view of the 2007 Declaration,

as [Mannhart] teach[es] MOCVD is a desirable method for forming the multilayer structures taught (paragraph [0041]) these same [superconductive film] structures are expected to individually identifiable and atomically bonded films as an inherent result. That is to say, the use of the same method is expected to produce the same result. If Appellant achieves a

² See, e.g., Mannhart ¶ 0040; Spec. 1:2-3.

³ Declarations under 37 C.F.R. § 1.132, respectively executed February 21, 2006, and August 6, 2007, and filed February 21, 2006, and August 7, 2007 (2007 Declaration).

⁴ We find it necessary to discuss only the 2007 Declaration which is directed specifically to Mannhart. 2007 Decl. ¶ 3.

different result it must be due to some limitation not currently claimed.

Ans. 9.

Thus, the Examiner considered the evidence in the Specification and the 2007 Declaration establishing that the structure of the superconductive films as specified in claim 23 is obtained by the particular MOCVD process disclosed in the Specification, in light of the disclosure of the generic disclosure of a MOCVD process in Mannhart. Ans. 9; *see also* Ans. e.g., 4-5. Mannhart ¶ 0041. Indeed, we fail to find in the record any scientific explanation or evidence adduced by the Examiner establishing that Appellants' disclosed MOCVD process was known in the art and would have been used by one of ordinary skill in the art in practicing the process of forming a semiconductor article set forth in Mannhart Example 1, or that all MOCVD processes would result in a semiconductor layer having the structure claimed in claim 1.

Thus, the Examiner's unsupported conclusory statements in these respects are entitled to little weight. Indeed, the absence of evidence supporting the Examiner's positions establishes that the Examiner did not have sound basis to believe that the claimed superconductive article encompassed by claim 23 and the superconductive article described to one of ordinary skill in this art in Mannhart Example 1 are identical or substantially identical, and accordingly, the burden did not shift to Appellants to establish otherwise. *See, e.g., In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) ("[W]hen the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not."); *cf., e.g., In re Jones*, 958 F.2d 347,

349-51 (Fed. Cir. 1992) (“Conspicuously missing from this record is any *evidence*, other than the PTO’s speculation (if it be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of the prior art salts necessary to arrive at the claimed . . . salt.”).

Accordingly, in the absence of evidence of obviousness, we reverse the ground of rejection advanced on appeal.

The Primary Examiner’s decision is reversed.

REVERSED

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